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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,762

03/05/2002

Marko Kesti

513-5

6862

7590

06/02/2006

Hoffmann & Baron, LLP  
6900 Jericho Turnpike  
Syosset, NY 11791

EXAMINER

KRSCIUNAS, LINDA MARY

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/091,762	KESTI, MARKO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Linda Krisciunas	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Sept 9, 2002</u>  | 6) <input checked="" type="checkbox"/> Other: <u>1.105</u>                  |

## **DETAILED ACTION**

1. The following is a Non-Final Office Action in response to the application filed March 5, 2002. Claims 1-10 are pending.
2. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Finland on April 24, 2001. It is noted, however, that applicant has not filed a certified copy of the 20010838 application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-10 merely recite collecting data and comparing it to a scale. It is unclear as to what is being optimized and how any sort of optimization is being controlled. The claimed invention is not definitive with respect to the process in claim 1, and thus is not tangible. Additionally, it does not produce a repeatable real-world result as the answers to the questions are subjective and may or may not be the same on a different day even by the same person. The claims also lack

usefulness since they are not specific or substantial, and thus they fail the concrete and useful portion of the 35 USC 101 requirement.

Under the statutory requirement of 35 U.S.C. 101, a claimed invention must produce a useful, concrete and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP 2107). A concrete result is one that is substantially repeatable, ie, it produces substantially the same result over and over again. In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, ie, the claim must be more than a mere abstraction. Additionally, a claim may not preempt abstract ideas, laws of nature or natural phenomena nor may a claim preempt every substantial practical application of an abstract idea, law of nature or natural phenomena because it would in practical effect be a patent on the judicial exceptions themselves. Thus, claims 1-10 are not statutory.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-4 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 3 recites the limitation "the segment line", "the angle value" and "the first end of the segment of line (P)" in lines 26 and 29. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to how the segment line, angle value and

first end of the segment of line P relate to the optimization and controlling process limitations of claim 1.

Claim 4 recites the limitation “the mentioned scale’s radius (R)” and “the pre-determined maximum value (I max)” in lines 34 and 1. There is insufficient antecedent basis for this limitation in the claim. It is unclear how the scale’s radius and predetermined max value relate to the optimization and controlling limitations of claim 1.

Claim 7 recites the limitation “a commitment value” in line 21. There is insufficient antecedent basis for this limitation in the claim. It is unclear how the commitment value related to the optimization and controlling limitations of claim 1.

Claim 8 recites the limitation “the saved angle values (S)” in line 5. There is insufficient antecedent basis for this limitation in the claim. It is unclear how the saved angle values relate to the optimization and controlling limitations of claim 1. In order to be part of the same invention, another independent claim should contain similar elements to the other independent claims, otherwise it is restrictable as a separate invention.

Claim 9 recites the limitation “the balanced probability (Tk)” in line 14. There is insufficient antecedent basis for this limitation in the claim. It is unclear how the balanced probability relates to limitations of claim 8 and the probability (T) value.

Claim 10 recites the limitation “a WAP browser” in line 19. There is insufficient antecedent basis for this limitation in the claim. It is unclear how the WAP browser interacts with the elements of claim 8, more specifically with the analyzer/calculating limitations.

9. Because claims 1-10 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); *Ex parte Brummer*, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMK

*LMK*  
*May 24, 2006*

  
TARIQ R. NAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

### **Request for Information Under 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.


In response to this requirement, please provide the citation and a copy of each publication which any of the applicants authored or co-authored and which describe the



In response to this requirement, please provide the citation and a copy of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of Non Patent Literature found on "World class design by world class methods" dated 1997 from ICED 97. In addition, it is requested that the applicant provide the source for the formulas provided in the Specification on pages 10-14 so the Examiner can fully understand the field of endeavor.

The information is required to identify products and services embodying the disclosed subject matter of application 10/091762 and identify the properties of similar products and services found in the prior art.

In response to this requirement, please provide the names of any products or services that have incorporated the disclosed prior art in application 10/091762.



TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600